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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,082	02/17/2004	Michael L. O'Banion	0275Y-625COD	9514

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EXAMINER

MITCHELL, KATHERINE W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,082

Applicant(s)

O'BANION ET AL.

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 92-102 is/are allowed.
- 6) ☒ Claim(s) 85-87, 90, 91, 104-106, 109 and 110 is/are rejected.
- 7) ☒ Claim(s) 88, 89, 103, 107 and 108 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 2 pages 5 pages km

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 4/15/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because documents 5,6,7, and 8 do not exist – that patent number, date, and inventor name are not valid. It has been placed in the application file, but the information referred to therein as regards to documents 5,6,7, and 8 has not been considered as to the merits. ALL OTHER DOCUMENTS WERE CONSIDERED. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Examiner notes for the record the exceptionally thorough job in preparing the IDS, and has tried to determine what documents 5,6,7, and 8 refer to, but could not. However, since the submission was so exceptionally thorough and on point, and documents 5,6,7, and 8 are obviously only typing errors, examiner will consider corrected documents 5,6,7, and 8 if applicant lists them in his response. Examiner will consider and list on a form 892, so applicant will NOT need to submit an additional IDS and fee – the 4 corrected documents can be listed in the amendment and examiner will prepare the 892.

Drawings

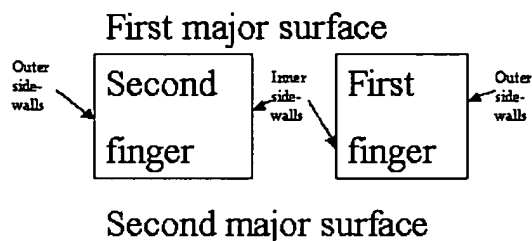
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2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show 50" as described in the specification para [0065] as appearing in Fig 11, or first set of teeth 40 as described for Fig 3 in paragraph [0055]. Also, Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Examiner is assuming, based on an interview with attorney in related case 10/780072, that the major surfaces and sidewalls are arranged as below:

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Top plan view of
fastener



4. Fig 4 should be described as a front view, not a side view, if Fig 3 is a side view. Examiner assumed teeth not labeled are teeth 40.

Specification

5. The disclosure is objected to because of the following informalities: the claim to priority in the first sentence should be to USP 6719512, not 6179512.

Appropriate correction is required.

Claim Objections

6. Claims 90, 91, 103, 105 are objected to because of the following informalities:
- It is an improper wording to describe one or more of a list of alternatives. A Markush Group and its application are discussed in the MPEP Paragraph 2173.05(h).

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925).

Ex parte Markush sanctions claiming a genus expressed as a group consisting of certain specified materials. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See Ex parte Head, 214 USPQ 551 (Bd. App. 1981); In re Gaubert, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975); and In re Harnisch, 631 F.2d

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716, 206 USPQ 300 (CCPA 1980). It is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931).

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.

Similarly, the double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear. For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro."

*The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (**MPEP § 803**) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.*

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper.

Appropriate correction is required.

- Further, claims 90, 103, and 105 include the phrase "ram-type" which renders the claim unclear because it is unclear exactly what structure is intended by "ram-type", especially since the included alternate appears to be a "ram-type" device to examiner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

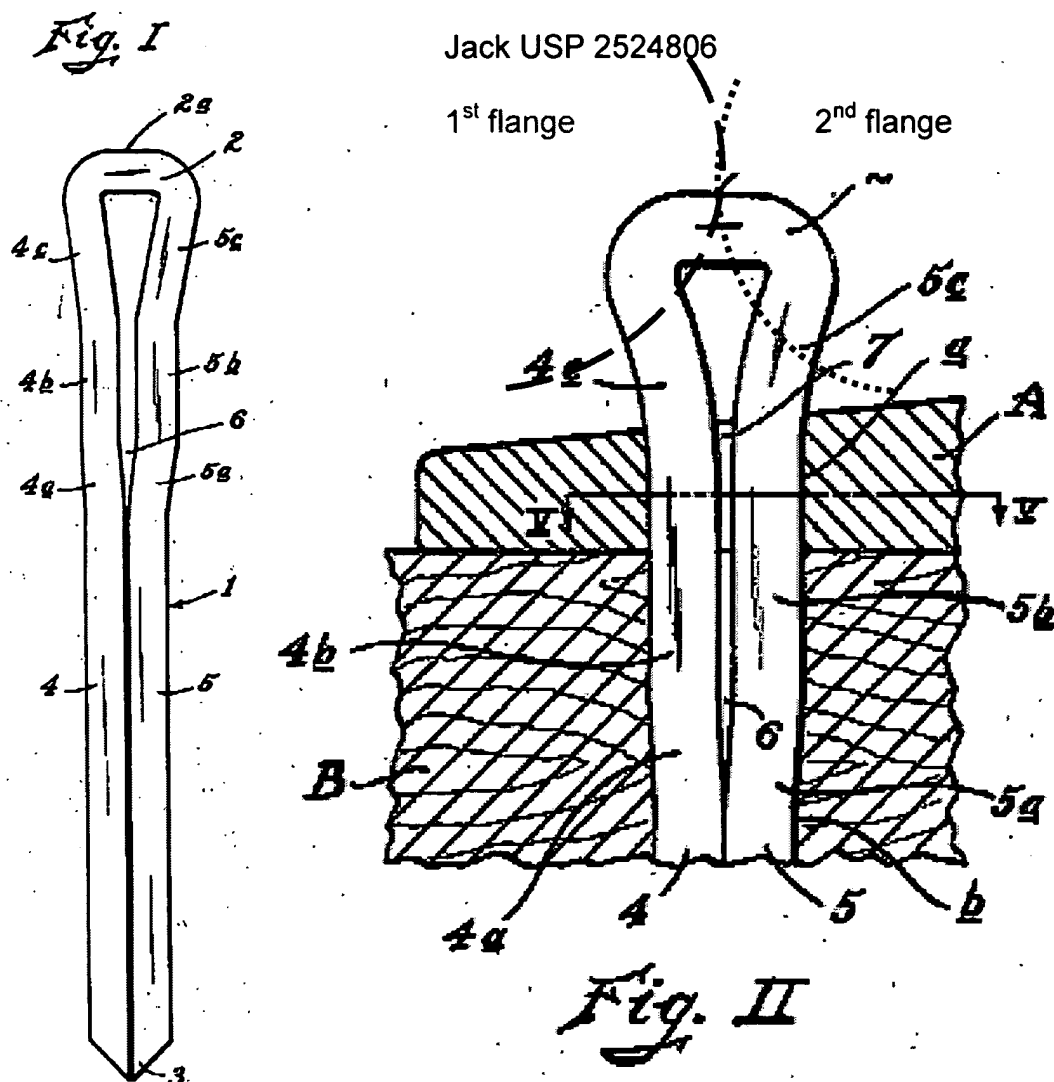
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 85, 86, 87, 90, 91, 104, 105, 106, 109, and 110 are rejected under 35 U.S.C. 102(b) as being anticipated by Jack, USP 2524806.

Re claims 85 and 104: Jack teaches in Figs I and II a nail capable of fastening framing members together comprising:

- First member (4) having elongated section (at 4 in Fig I), a flange segment (Shown in Fig II as marked up by examiner above as the section included by the **dashed** arc, red in electronic version, please assume a more vertical split of “2”), and an angular segment 4a, 4b not parallel to elongate and flange segments ; and
- Second member (5) having elongated section (at 5 in Fig I), a flange segment (Shown in Fig II as marked up by examiner above as the section included by the **dotted** arc, blue in electronic version), and an angular segment 5a,5b not parallel to elongate and flange segments ; and



- Wherein said elongated segments are substantially parallel to one another and form a tip (3) configured to penetrate adjacent framing members (A,B, Fig II), said 1st and 2nd members configured to receive a driving force that drives a portion of said 1st and 2nd members through said framing members (col 3 lines 50-64) said driving capable of causing said angular segments to move toward one another and said elongated

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segments to move away from each other (col 4 lines 39-72), thereby fastening said framing members together between said elongated and flange segments (Fig II).

Further Re claim 104: The method is inherent in the structure, and detailed in col 3 line 59 – col 4 line 61. Note that as the angled segments compress, inherently by the laws of physics including Newton's 3rd law, a reacting force will serve to separate the elongated sections to some degree. Further blows will serve to place the flange segments in contact with one of the framing members, although examiner notes that direct contact is not required.

Re claim 86: Fig II shows the flange segments substantially perpendicular to said angular segments.

Re claims 87 and 110: "2" couples the elongated segments together prior to driving. Note that applicant did not claim **directly** coupled. They will be inherently somewhat uncoupled after driving as discussed with claim 104.

Re claims 90 and 105: The first and second members are configured to be driven by an air nailer or a ram-type device, since the structure is capable of meeting this intended use.

Re claim 91: At least one of said angular and flange segments is configured to receive said driving force, per col 3 lines 50-64.

Re claim 106: A surface of one of the framing members is supported by the earth's surface, which can be considered a back plate.

Re claim 109: The angular segments are brought toward one another as the nail passes through the framing members, per Fig II and col 4 lines 39-72.

Allowable Subject Matter

9. Claims 92-102 are allowed.
10. Claim 103 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
11. Claims 88, 89, 107, and 108 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

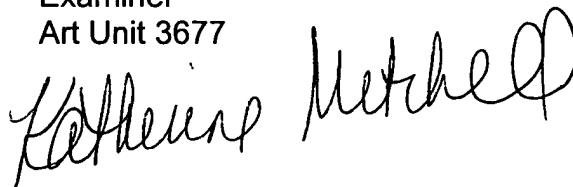
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Examiner
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A handwritten signature in black ink, appearing to read "Katherine Mitchell", written in a cursive style.

Kwm
1/19/2005